

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Juan M. JIMENEZ MAYORGA et al.) Group Art Unit: 1626
Application No.: 10/555,286)
Examiner: Sun Jae Y. LOEWE
§371 filing date: October 17, 2006) Confirmation No.: 9323
For: N-(2-PHENYLETHYL))
SULFAMIDE DERIVATIVES AS)
INTEGRIN α 4 ANTAGONISTS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Restriction Requirement dated May 29, 2008, ("Restriction Requirement") the Examiner required restriction under 35 U.S.C. §§ 121 and 372 among the claims of Groups I to III.

Applicants traverse the Restriction Requirement on the grounds that it is improper under the standard set forth in 37 C.F.R. § 1.475. In order to be fully responsive, however, Applicants provisionally elect to prosecute the claims of Group I, which includes claims 1-10, 20, and 21, drawn to products of formula I. The Office also required the election of a species falling within the scope of the elected claims.

Applicants provisionally elect (2S)-3-{4-[(3,5-dichloroisonicotinoyl)amino]phenyl}-2-[(diisobutylamino)sulfonyl]amino}propionic acid, which is the product of Example 11. From among the claims in Group I, claims 1-10, 20, and 21 read on the elected species.

The Office argues that the special technical feature linking the claims is taught in WO97/19919. Restriction Requirement at 2. However, the Office has improperly and

narrowly selected the special technical feature linking the instant claims as the "core N-SO₂-N-C-CH₂-phenyl." *Id.* The Office has failed to recognize that the special technical feature linking the claims is not limited to the core structure cited by the Office, but also encompasses the position and identity of the radicals R1 to R6, which are also part of the structure of instant compounds of formula (I). One of the major differences between the "core structure" in WO97/19919 and the instant compounds is the presence of a -(C=O)R2 moiety in WO97/19919, in which R2 is an "optionally substituted and fused nitrogenous heterocycle." WO97/19919 at Abstract. Such moiety is not present in the instant compounds. For at least this reason, the Office has not met its burden of proving a lack of unity of invention and Applicants respectfully request that the Restriction Requirement be withdrawn.

Additionally, Applicants respectfully remind the Examiner of the rejoinder procedure of M.P.E.P. § 821.04. This section of the M.P.E.P. provides that claims directed to a nonelected processes of making or using a product are subject to rejoinder with claims drawn to that product once the product is found patentable. See also *In Re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996). The M.P.E.P. requires that "[i]n order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim." *Id.*

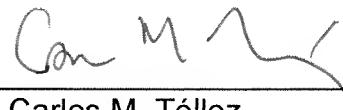
In this regard, claims of Groups II and III, which are directed to methods of treating comprising administering a compound as claimed in claim 1 and methods of making a compound as claimed in claim 1, respectively, comply with this provision. Therefore, these claims are eligible for rejoinder once the compounds of claim 1 are

found patentable. Accordingly, pursuant to this rejoinder procedure, Applicants respectfully request that claims of Groups II and III be examined together with the claims of Group I in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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Dated: June 24, 2008